

### **REMARKS**

Claims 65-104 are pending and at issue.

Pursuant to Paragraph 2 of the official action, Applicant has added the claims from the reexamination certificate RE 37,585 F1, as claims 1-64. Applicant asks that the Examiner to please add claims 1-64, as canceled (as reflected by their enclosure in brackets, save claim 6 which is presented in strikethrough), and please enter claims 65-104, which are the same as previous claims 46-50, 52-54, 56-66, 68-80, and 106-113, but renumbered per the Examiner's suggestion.

Claims 1-64 are not at issue in this case and are not affected by this renumbering. They are included only to comply with the form request of Examiner Evans.

Further, Applicant has renumbered the actual claims at issue to expedite final allowance of this application. Applicant does not intend this renumbering to reflect Applicant's acquiescence on whether the claims of this application should be properly renumbered based on the reexamination claims. Applicant maintains that the present application was filed before the reexamination application that resulted in RE 37,585 F1 and does not relate to that application. Indeed, Applicant intends to file a petition under 37 C.F.R. 1.181 to request the Director to address the question of the estoppel.

Applicant nevertheless has requested (1) entry of the amendments renumbering the claims and (2) entry of the substantive amendments that, as discussed below, address the estoppel rejection raised by the examiner by adding claim language from RE 37,585 F1 identified by the Examiner. As a result, and even without resolving the merits of the estoppel rejection, Applicant respectfully asserts that this case is in condition for allowance in light of the claim amendments.

In any event, after the renumbering, claims 65-98 are pending and at issue. Please note, per the Examiner, Applicant has not renumbered the previously canceled claims. A chart of the renumbered claims and corresponding previous claims is provided below.

At Paragraph 3, the official action rejects claims 46-50, 52-54, 56-66, and 106-113 under 35 U.S.C. § 251, as being broader than the claims of RE 37,585 F1.

At Paragraph 4, claim 106 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite due to multiple dependencies upon cancelled claims.

At Paragraph 7, the official action confirms that claims 46-50, 53, 54, 56-66, 68-80, and 107-113 recite allowable subject matter.

At Paragraph 8, the official action confirms that claim 106 recites allowable subject matter.

Applicant respectfully traverses each of the rejections and requests their removal.

## **I. Status of Claims**

Claims 65-104 are pending and at issue. These claims have been renumbered from claims 46-50, 53, 54, 56-66, 68-80, and 106-113, which were previously present in the application. Each of the previous independent claims 46, 47, 48, 49, 50, 78, 79, and 80 has been amended from their corresponding prior corresponding claim to include language suggested by the Examiner.

In light of the renumbering of claims, the status indicators below have been updated to reflect the number of times a claim has been amended based on the number of times the corresponding, previous claim was amended. For example, renumbered claim 65 corresponds to previous claim 46, which had been previously amended four times. Because that previous claim 46 is being amended herein, renumbered claim 65 is listed as amended five times, as indicated below.

Claims 65, 66, 67, 78, 69, 94, 95, and 96 are currently amended. The claims in bold are the currently amended claims. The status of the claims is as follows:

### **Claim Status Chart Previously Numbered Claims vs. Currently (Renumbered) Claims**

Previous Claim	Renumbered Claim	Total Number of Times Amended
<b>46</b>	<b>65</b>	<b>Five Times Amended</b>
<b>47</b>	<b>66</b>	<b>Five Times Amended</b>
<b>48</b>	<b>67</b>	<b>Five Times Amended</b>
<b>49</b>	<b>68</b>	<b>Five Times Amended</b>
<b>50</b>	<b>69</b>	<b>Four Times Amended</b>
52	70	Thrice Amended
53	71	Twice Amended
54	72	Twice Amended

56	73	Four Times Amended
57	74	Twice Amended
58	75	Amended
59	76	Twice Amended
60	77	Amended
61	78	Twice Amended
62	79	Twice Amended
63	80	Amended
64	81	Amended
65	82	Twice Amended
66	83	Twice Amended
68	84	Amended
69	85	Amended
70	86	Amended
71	87	Amended
72	88	Twice Amended
73	89	Amended
74	90	Amended
75	91	Amended
76	92	Four Times Amended
77	93	Four Times Amended
<b>78</b>	<b>94</b>	<b>Six Times Amended</b>
<b>79</b>	<b>95</b>	<b>Six Times Amended</b>
<b>80</b>	<b>96</b>	<b>Six Times Amended</b>
106	97	Amended
107	98	Amended
108	99	Amended
109	100	Amended
110	101	Amended
111	102	Amended
112	103	Amended
113	104	Amended

## II. Reissue Oath/Declaration

Applicant will provide a supplemental reissue oath/declaration upon confirmation of the allowability of the pending claims.

### **III. Rejections under 35 U.S.C. § 112, second paragraph**

The official action rejects claim 106 (now claim 97) as depending from multiple deleted claims. Applicant has corrected renumbered claim 97 by amendment above to remove those improper dependencies. Applicant respectfully traverses the rejection.

### **IV. Rejections under 35 U.S.C. § 251**

The official action rejects the previously pending claims as being broader than that of the Reexamination Certificate RE 37,585 F1. Applicant has explained that this rejection is improper, both in substance – the recited MPEP section simply does not apply to the instant situation – and in implementation – the procedures cited by the MPEP that were to be followed by the patent office to address a possible estoppel situation were never followed.

In response to the impropriety of these rejections under § 251, Applicant is intending to separately file a petition to the Director for reconsideration of the rejection, under 37 C.F.R. 1.181. Applicant has also filed an appeal in co-pending application Serial No. 09/775,069, requesting at least pre-appeal brief review of the exact same § 251 rejection levied in that case.

Meanwhile, in the instant application, Applicant has addressed the § 251 rejection by amending the independent claims, per the suggestion of the Examiner, to include the “by itself” language from the RE 37,585 F1. For example, previous claim 46, now renumbered claims 65 recites as follows (with the current amendment emphasized):

65. A method of ablating or changing properties in structure of an opaque or a transparent material by laser induced breakdown with a pulsed laser beam, said method comprising the steps of:

generating a beam of one or more laser pulses characterized by a pulse width approximately equal to or less than a pulse width at which laser induced breakdown becomes essentially accurate at a corresponding fluence, wherein each laser pulse with has a fluence to cause breakdown itself;

configuring the beam such that a first area within a spot size of the beam exceeds a breakdown threshold and such that a second area within the spot size does not exceed the breakdown threshold;

directing said beam to the opaque or transparent material; and

scanning the beam along a predetermined path beneath the surface of the opaque or transparent material to induce laser induced breakdown therein to a depth smaller than the Rayleigh range,

said essentially accurate breakdown being determinable by a distinct change in breakdown threshold accuracy.

Applicant's amendment to previous claim 80, now renumbered claim 96, is provided for example as well (with the current amendment emphasized):

80. (Previously presented) A method for laser induced breakdown of a first layer of an opaque or a transparent material adjacent a second layer of the opaque or transparent material with a pulsed laser beam, without substantially affecting the second layer, the first layer being characterized by a relationship of fluence threshold at which breakdown occurs versus laser pulse width that exhibits a distinct change in slope at a characteristic laser pulse width, said method comprising the steps of:

generating at least one laser pulse which has a pulse width equal to or less than said characteristic laser pulse width;

configuring the pulsed laser beam such that a first area within a spot size of the pulsed laser beam exceeds the fluence threshold and such that a second area within the spot size does not exceed the fluence threshold, wherein the at least one pulse has a fluence to cause breakdown itself;

directing said pulse to a point at or beneath the surface of the first layer; and

scanning the beam along a predetermined path beneath the surface of the opaque or transparent material to induce laser induced breakdown therein to a depth smaller than the Rayleigh range.

Applicant has amended all the independent claims in light of the Examiner's suggestion at Paragraph 3 of the office action. Therefore, Applicant respectfully asserts that the rejections under § 251 are moot in light of the amendments. Applicant respectfully asserts that the claims are in condition for immediate allowance and an expedited confirmation of the same is respectfully requested.

## **V. Conclusion**

In light of the foregoing, Applicant respectfully asserts that claims 65-104 are in condition for immediate allowance. Confirmation of the same is respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, he is urged to telephone the undersigned at the indicated number.

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Respectfully submitted,

By\_\_\_\_/Paul B. Stephens/\_\_\_\_\_

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